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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/700,150

02/05/2001

Fumio Nagumo

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EXAMINER

SRIVASTAVA, VIVEK

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/700,150

Applicant(s)

NAGUMO, FUMIO

Examiner

Vivek Srivastava

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant argues Zigmond does not teach receiving commercial information and then the program information on the same channel as required in the present invention.

The Examiner respectfully disagrees. See rejection below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17 – 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al (US 6,698,020).

Regarding claims 17 and 24, Zigmond discloses a information receiving device and method for receiving separately transmitted program information and commercial information with the program (see fig 4 and fig 5). It is noted that the commercial delivery and program delivery are separate but from the same source i.e. the

advertisement content provider is the same as the video programming content provider (see col 8 lines 17 – 20). Zigmond further discloses transmitting and receiving commercial information and program information over a satellite communication channel or 'first channel'. Zigmond further disclose "In one implementation, ad source 62 transmits advertisement streams 64 only periodically over satellite 134, in which case, a device such as advertisement repository 86 of FIG. 5 may be used to store the transmitted advertisements for later selection and display" (see col. 17 lines 50 – col. 18 line 13). Thus, Zigmond discloses receiving the commercial information before the program information.

Zigmond further teaches a user can set the rules for displaying a commercial (col 11 lines 50 – 52) and thus discloses the claimed 'condition setting means for a viewer to set display conditions for the commercial information'.

It is further noted that the set of rules are inherently formed by control means for forming control data as necessary for controlling commercial insertion (see col 11 lines 50 – 52).

Zigmond further discloses a video switch 68 located in ad insertion device 60 (see fig 4) for selectively selecting the commercial and program to form a combined output signal for display on display 58.

Zigmond further discloses a transmission means and the user side for transmitting control data to a source company which transmits the program information and the commercial information (see col. 4 lines 55 – 65, col. 7 lines 57 – 67, col. 11 lines 48 – 58, col. 15 lines 2 – 16).

Regarding claims 18 and 25, Zigmond discloses a advertisement repository 86 (fig 5) for storing or recording the commercial information.

Regarding claims 19 and 27, Zigmond discloses the advertising rules can be selected by the information provider (see col 11 lines 50 – 54) and also discloses the advertisers can target ads (see col 9 lines 24 – 38).

Regarding claims 20 and 26, Zigmond discloses charging a fee based on blocking of commercials (see col 14 lines 25 – 35).

Regarding claims 21 and 28, Zigmond discloses a user can block all advertisements all together (see col 14 lines 28 – 32) thus indicating a ratio of 1 to 0 i.e. programming to advertisements.

Regarding claims 22 and 29, Zigmond discloses charging a fee for blocking commercials and thus discloses the claimed 'display conditions indicate the commercial information should not be combined with the program information (see col 14 lines 25 – 35).

Regarding claims 23 and 30, Zigmond discloses the claimed 'display conditions indicate classifications of the commercial information which should be combined with the program information (see 'certain goods and services' in col 14 lines 36 – 48 and a specify a viewer's hobbies, interests, spending habits, and anticipated major purchases in col 10 lines 60 – 64).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (571) 272-7304. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272 – 7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs
2/13/06



VIVEK SRIVASTAVA
PRIMARY EXAMINER